

- (1) an effective amount of a bioactive compound mediating respiratory depression, muscle rigidity, and/or nausea/vomiting as an unwanted side effect thereof, with the proviso that said bioactive compound is not morphine; and
- (2) a delta receptor agonist.

74. A pharmaceutical composition comprising:

- A 2 (1) an effective amount of a bioactive compound mediating an unwanted side effect thereof; and
- (3) a non-polypeptide δ receptor activating agent effective for combating said side effect.

75. The pharmaceutical composition of claim 74, wherein the δ receptor activating agent comprises a diarylmethylpiperazine or a diarylmethylpiperazine compound.

REMARKS

Enclosed is a true and exact copy of the prior copending application No. 09/352,308. The claims 1-46 have been cancelled and new claims 47-75 have been added herein.

The fees for this application have been calculated based on the number of claims in the application after the entry of this amendment. Please charge any deficiency and credit any excess to deposit account 08-3284 of Intellectual Property/Technology Law.

Respectfully submitted,



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and

3. said compound acting to attenuate the respiratory depression side effect of the therapeutic agent without precluding the therapeutic efficacy of the therapeutic agent.

Clearly, the compositions of Chang '858 define a third necessary element, wherein compound (2) must reduce the negative side effects of agent (1) without affecting the therapeutic efficacy of agent (1).

In contrast, the claims of the present invention do not include the third element as recited in Chang '858, and as such, is not patented in Chang '858. It is evident that the claims of the present application and those of Chang '858 are not co-extensive in scope. If one claimed invention has a broader scope than the other, then the same invention is not claimed twice and the second inquiry¹ must be made as to whether the claims of the application define an obvious variation of the other patent claim which may be overcome by filing a terminal disclaimer.

Applicants submit that the Office has failed to establish a *prima facie* case of same-invention double patenting and request that the rejection under 35 U.S.C. §101 be withdrawn.

Conclusion

Applicants have satisfied all the requirements for patentability. All pending claims are free of the art and fully comply with the requirements of 35 U.S.C. §112. It therefore is requested that Examiner Weddington reconsider the patentability of claims 47-75 in light of the distinguishing remarks herein and withdraw all rejections, thereby placing the application in condition for allowance. Notice of the same is earnestly solicited. In the event that any issues remain, Examiner Weddington is requested to contact the undersigned attorney at (919) 419-9350 to resolve same.

¹ *Id. In re Goodman*



Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Marianne Fuierer".

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